

REMARKS

The Examiner has rejected claims 1 and 3-22 under 35 U.S.C. 103(a) as being unpatentable over Andrew et al. (US 4,136,879). Respectfully, the above amendments do not include new matter nor would they require further search or consideration. Claim 1 has been amended to include the limitations of claim 14. Claim 14 has been hereby cancelled. New claim 23 includes all the limitations of claim 2 as filed in the Preliminary Amendment and has been previously considered by the examiner as original claim 2. Thus, further search and consideration should not be required.

The Applicant respectfully traverses the '103 rejection with the following arguments.

35 U.S.C. 103(a)

The Examiner asserts that claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrew et al. (US 4,136,879).

The Examiner alleges that Andrew et al., teaches a game board (Fig. 1), a plurality of markers (Fig. 4), a plurality of spaces (A1-A7 etc), start space (11), a plurality of cards (Fig. 7-12), random number generator (Fig. 3), and badges (Fig. 5). The Examiner alleges that the only difference between the applicant's game and the applied reference resides in meaning and information conveyed by the printed matter, which is not considered patentable *Ex Parte Breslow* 192 USPQ 431. The Examiner also argues that it would have been obvious to change the information on the spaces/cards to match the theme of the game.

In response to the obviousness objections, the Applicant has amended claim 1, cancelled claim 14 and added new claim 23. The Applicant argues respectfully that Andrew et al., do not teach or suggest a board game as claimed, *inter alia*, comprising a game board having an outer circle, an inner circle and a center region, wherein the outer and inner circle include spaces for movement of player markers, and wherein the center region includes a map and district spaces that are separate from the plurality of spaces

and correlate to locations on the map. In addition, Andrew et al., do not teach or obviate **rank badges** as in amended claim 1 nor do they teach of **district markers** which are separate from the player markers as in claim 23.

The Examiner alleges that Andrew et al., teaches of rank badges and refers to the personnel cards 69 shown in Figure 5 as evidence to support his allegation. It is with due respect that the personnel cards taught by Andrew et al., are quite dissimilar in both structure and function from the **rank badges** of the present invention. A rank badge is an emblem worn as an insignia of rank in an organization. Twenty-eight personnel cards, seven for each of the four specialties are provided in the game taught by Andrew et al. (column 5, lines 8-10). There is nothing to teach or suggest that the personnel cards of Andrew et al. are insignia's to be worn as would a badge. Conversely, 20 color-coded Fire Service Badges are provided in the present invention (paragraph [0046]).

The seven personnel cards for each specialty are identified by the title of an individual typically found working in a hospital ward. For example, cards identified by the titles: Attending Physician, Resident, Head Nurse, Nurse, Secretary, and Orderly are provided as the personnel cards common to all wards and a Social Worker card specific to Medicine, Physical Therapist card specific to Neurology Psychiatry, Physician's Associate card specific to Surgery and Dietitian card specific to Gynecology Obstetrics are also provided (column 9, lines 23-28). Conversely, the Fire Service Badges of the present invention correspond to a particular rank within the Fire Service. For example, the lowest rank a player can have is Firefighter, which is represented by ownership of a black Fire Service Badge, whereas ownership of a red badge indicates the highest rank of Fire Chief. Intermediate ranks of Lieutenant, Captain, and Deputy Chief are represented by ownership of Fire Service Badges colored coded white, blue and yellow, respectively (paragraph [0072]).

The personnel cards are equally distributed to each player at the beginning of the game depending on the number of players playing the game (column 6, lines 29-31). For example, if four individuals are playing the game taught by Andrew et al., each will receive seven personnel cards corresponding to the ward in which they have elected to be the intern thereof. These personnel cards are neither obtained nor discarded during play. In other words, the number of personnel cards received by the player at the beginning of

the game remains with that player throughout the game and number of personnel cards received at the outset of the game is only determined by the number of players playing the game. For example, if four or less players are playing, each player will receive the maximum number of personnel cards. Alternatively, if more than four players are playing, the personnel cards are divided equally between the players. In other words, if six players were engaged in the game, each player would receive three personnel cards and at least two players would have personnel cards from the same specialty or ward. The mere fact that one player has the personnel cards entitled Attending Physician, Resident, and Head Nurse and another player has the personnel cards entitled Nurse, Secretary, and Orderly does not have any bearing on the way the game is played or the status (or rank) of the player with respect to the other players.

At the beginning of the game described and claimed in the present invention, each player receives one rank badge representing the rank of Firefighter (paragraph [0049]). At the outset of the game, each player receives the same rank (i.e. Firefighter), since the rank of the player materially effects the way the game is played. During play, a player attempts to obtain a higher rank than the one currently held, with the ultimate goal of achieving the rank of Fire Chief (paragraph [0049]). During the course of game, a player can be either promoted or demoted by exchanging their current rank badge for either a rank badge corresponding to a higher rank in the fire service or a rank badge of lower rank in the fire service (paragraph [0087]). In other words, at any given time during the game the player will have no more than one rank badge in their possession. The player cannot be demoted to a rank lower than Firefighter and promoted to no higher than Fire Chief (paragraph [0049]). The various ranks are obtained by the player by either landing on the space that says A Fire Service Promotion@ or through the instructions provided on a Station Duties card (paragraph [0087]).

As mentioned above, the personnel cards taught by Andrew et al., have no bearing on the way the game is played. In fact, the sole function of the personnel cards taught by Andrew et al., is to conceal the diagnosis and treatment cards in the possession of the player from the other players (column 7, lines 58-60, and claim 7). The Applicant firmly submits that the mere fact that one player has personnel cards with titles of positions of high rank in a hospital ward and another player has personnel cards with titles of

positions of subordinate ranking in a hospital has absolutely no effect on the way the game is played or the status of the player with respect to the other players. In fact, any means capable of concealing the diagnostic and treatment cards in the possession of the player could be used to achieve the same result as the personnel cards. These concealing means could be cards with any type of printed matter thereon. The fact that Andrew et al., have elected to define these cards as personnel cards seems like an obvious choice to match the theme of the game.

As mentioned above, the rank badges of the present invention correspond to a rank in the fire service and each player starts the game with one rank badge corresponding to the lowest rank in the fire service, i.e. Firefighter. The rank of the player within the fire service, determined by the type of rank badge possessed by the player, dictates how much fire service equipment is required by that player to respond to a particular task (paragraph [0016]). For example, if a player having a black rank badge, thus holding the rank of Firefighter, were to land on a Fire Call space on the game board and draw the Fire Call card shown in Figure 2b, the player would require nine equipment cards corresponding to the pieces of equipment listed on the card (i.e. High Angle Rescue Equip, Cascade System, Extension Ladder, Aerial Truck, Ventilation Saw, Class AA Foam, 100 ft. of Hose, Salvage Cover, and Vehicle Extrication) in order to respond to the Fire Call and claim the district indicated on the Fire Call card. On the other hand, if a player having a red rank badge, thus holding the rank of Fire Chief, were to land on a Fire Call space on the game board and draw the Fire Call card shown in Figure 2b, the player would require only five equipment cards corresponding to the pieces of equipment listed on the card (i.e. Ventilation Saw, Class AA Foam, 100 ft. of Hose, Salvage Cover, and Vehicle Extrication) in order to respond to the Fire Call and claim the district indicated on the Fire Call card.

For the reasons stated above, the Applicant firmly submits that Andrew et al., does not disclose or suggest of the rank badges described and claimed in the present application. Moreover, the Applicant submits that the differences between the personnel cards disclosed by Andrew et al., and the rank badges of the present invention are more than mere differences in the printed matter.

Further patentable distinction between the present invention and Andrew et al., can be found in claim 3 previously presented and claim 23 submitted herewith. The present invention describes and claims a plurality of district markers, which are separate from the plurality of player markers for placement on an obtained district spot to indicate ownership thereof, regardless of whether the district spot was previously owned or not. The Examiner has not specifically identified what he considers to be the equivalent of the district markers of the present invention in the Andrew et al., reference. The Applicant has carefully studied the Andrew et al., reference and cannot find within the text of the Andrew et al., document any direct disclosure or suggestion of district markers or similar elements.

The district markers of the present invention are provided to each player before play begins. Each player receives 10 district markers corresponding to the color of the Fire Department they have elected to represent (paragraph [0048]). An object of the game is to occupy as many district spots as possible by successfully responding to a Fire Call and placing a district marker on the corresponding district spot (paragraph [0073]). If the district spot has already been covered by another opponent's district marker, the player removes the opponent's district marker and places his/her own marker on the district spot. The game is over once all the district spots are covered and one Fire Department holds a majority of the districts (paragraph [0056]). Conversely, Andrew et al., does not teach or suggest of a marker that is placed on the game board to identify that a task has been successfully completed and a certain space is owned, either permanently or temporarily, by the player. Moreover, the game taught by Andrew et al., is not won by the player who occupies the most number of spaces on the board. Instead the game taught by Andrew et al., is ended when one player, or intern, has discharged or transferred all of his/her patients (column 8, lines 30-31), represented by the cards shown in Figure 7. The winner of the game is determined by the player who has the highest score once the scores for each player have been tabulated using the complex formula shown in column 8, lines 32-44.

For the reasons stated above, the Applicant firmly submits that Andrew et al., does not disclose or suggest of the district markers described and claimed in the present

application. Accordingly, the Examiner is kindly requested to reconsider his objection made under the authority of 35 U.S.C. 103(a).

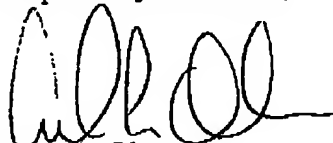
The examiner has alleged that one of ordinary skill in art at the time the invention was made would have suggested indicia on spaces/cards to promote a game. The applicant strongly disagrees with this position taken by the examiner. In fact, with due respect, the Examiner's position represents a classical *ex post facto* analysis of the inventive merit of the invention taught herein. This form of analysis is believed to be an unfair assessment of the inventive merit of the subject matter taught in the revised claims. This classical *ex post facto* analysis employed by the examiner has been deprecated by the Courts in most countries of the world and the applicant respectfully rejects its application in this instance. Indeed the applicant respectfully submits one of ordinary skill in the art would not have suggested the modifications inventively developed by the applicant. The fact is that not one of the imaginary individuals of ordinary skill in the art BA thought of the present invention. They failed to recognize the total structure and operation of the game presented herein. The individual of ordinary skill in the art in no way contemplated the specifics of the present invention and it is believed regrettable and unfair that the examiner is seeking to exert the negativism embodied in the principle of *ex post facto* analysis seeking to nullify the inventive merit clearly apparent herein. The fact that no one of ordinary skill in the art recognized the advances and advantages enjoyed by the present invention is well personified by the fact that it has been very well received commercially by those to whom the game has been presented. Although principles of law dictate in substance and essence that commercial success in and of itself may not be regarded as persuasive in assessing the existence of inventive merit, there is adequate case law to dictate that commercial success and commercial acceptability by the alleged one of ordinary skill is more than sufficient to tip the scales in favor of a determination of the presence of inventive merit. Accordingly, the applicant respectfully requests the examiner to reappraise his position on the matter of obviousness and inventive merit and rule in favor of the applicant.

CONCLUSION

The Applicant respectfully submits that the entire application is now in condition for allowance. The Director is hereby authorized to charge and/or credit Deposit Account 19-0513.

Date: 3-13-2006

Respectfully Submitted,



Arlen L. Olsen

Registration No. 37,543

Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850